

REMARKS/ARGUMENTS

Claims 25 and 26 stand rejected. No claims have been amended. No claims have been added. Claims 1-18 and 27 were previously cancelled, claims 19-24 and 28-38 were previously withdrawn, and claims 25 and 26 remain pending in the instant application. No new matter has been added. For the reasons set forth below, Applicant respectfully requests that the Examiner reconsider the rejections and allow all of the pending claims.

Claim Rejections Under 35 U.S.C. 103(a)

On page 2 of the Office Action, claims 25 and 26 are rejected under 35 U.S.C. §103(a) as being unpatentable over Dedrick, U.S. Patent No. 5,717,923 (hereinafter, “Dedrick”) in view of Achacoso et al., U.S. Patent No. 6,161,149 (hereinafter, “Achacoso”).

At the outset, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *Ex Parte Kune, et al.*, 2006 WL 2558178 (Bd. Pat. App. & Interf. 2006) citing to *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990). Although the teaching-suggestion-motivation test is no longer “rigidly applied,” patent law precedent still requires that to find a combination obvious there must be at least an implicit motivation in the prior art to select the teachings of separate references and combine them to produce the claimed combination. *KSR International Co., v. Teleflex Inc., et al.*, 127 S.Ct. 1727, 1742, (U.S. 2007) citing to *Alza Corp. v. Mylan Labs., Inc.*, 464 F.3d 1286, 1291, (Fed. Cir. 2006) While “the motivation to combine may be found ‘implicitly’ in the prior art,” the Supreme Court nevertheless continues to caution that a “factfinder should be aware, of course, of the distortion

caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning.”
(*Id.*)(citations omitted).

Applicant respectfully submits that there is no motivation, express or implied, for combining the teachings of Dedrick and Achacoso because the two inventions are used for different purposes and perform different functions. For example, the invention of Dedrick is limited to generating and transmitting electronic advertisements to end users [See Dedrick, for example, at Col. 1, ll. 36-57, Col. 4, ll. 11-55, Col. 5, ll. 21-33, Col. 6, l. 34 to Col. 7, l. 35, Col. 8, l. 64 to Col. 9, l. 24] On the other hand, Achacoso limits the invention to communication and collaboration tools designed for use in products such as groupware and group collaboration software [See Achacoso, for example, at Col. 1, ll. 5-17, Col. 2, l. 46 to Col. 3, l. 14, Col. 5, l. 60 to Col. 6, l. 17]. Other than the respective use of each disclosed invention as they relate to communicating electronic information across networks, there exists no implicit or explicit crossover in either patent to support a motivation to combine the references.

Moreover, Applicant asserts that Achacoso does not cure the deficiencies of Dedrick. Achacoso also fails to disclose, teach or suggest “pushing, by the member, individually selected data elements associated with the member to other respective users; and allowing the other respective users to transmit information to the member based on the individually selected data elements.” Achacoso does not provides for “pushing” individual selected data elements associated with the member. Rather, only hyperlink URLs or notices in an e-mail or other notification are generated and pushed to other members of the group, not the data elements themselves. Achacoso emphasizes this “important” part of the invention:

"CCCM can be used in non-computer-based networks, provided there is bi-directional exchange of information, including telecommunication systems, newer versions of cable-based networks, wireless networks and others. The invention does not much depend on how the network is linked. What is important is that each database record or field has a URL or similar "retrievable handle" that can be accessed for retrieval by the network, and that this URL or handle can be "pushed" in various ways (like e-mail) so that following (or clicking on) the link will retrieve the database record or field." Achacoso at Col. 6, ll. 18-28.

Therefore, even if Dedrick were combined with Achacoso, the combination would neither teach nor suggest "pushing, by the member, individually selected data elements associated with the member to other respective users; and allowing the other respective users to transmit information to the member based on the individually selected data elements." as recited in claims 25 and 26.

For at least the foregoing reasons, Applicant submits that claims 25 and 26 are patentable over Dedrick in view of Achacoso whether taken alone or in any reasonable combination.

CONCLUSION

On the basis of the above remarks, reconsideration and allowance of all the pending claims is believed to be warranted and such action is respectfully requested. If the Examiner has any questions or comments, the Examiner is respectfully requested to contact the undersigned at the number listed below. The Office is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1847.

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Respectfully submitted,

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